

Stein et al.

S/N: 10/605,546

REMARKS

Claims 1-23 are pending in the present application. In the Office Action mailed July 19, 2005, the Examiner rejected claims 1-23 under the judicially created doctrine of obviousness-type double patenting. The Examiner next rejected claims 1-23 under 35 U.S.C. §102(b) as being anticipated by Prunier (FR 2, 536,320). Claims 1-23 were rejected under 35 U.S.C. §102(b) as being anticipated by Behnke et al. (USP 2,510,207).

The disclosure was objected to because of certain informalities. Applicant has made the appropriate corrections.

The Examiner further indicated that the IDS originally filed December 13, 2004 did not include five (5) of the six (6) foreign documents cited therein. The Examiner states that "[t]he applicants are reminded of 5 foreign documents not provided/considered in the IDS of December 13, 2004." Applicant assumes that the Examiner is referring to the IDS originally filed December 7, 2004. The Examiner's only prior mentioning of this lacking was inadvertently unaddressed as the statement is indicated on the equivalent to Form PTO-1449 wherein the Examiner's hand written notes indicate certain references were not provided. The body of the Office Action does not mention that certain references submitted with the IDS of December 7, 2004 were not received. Although Applicant finds it curious that the Postcard Receipt indicates that six references were received and the Examiner only received one of the six references, Applicant does not find such an inconsistency inconceivable. Applicant has mailed concurrently herewith, under separate cover, a courtesy copy of the IDS filed December 7, 2004 with the foreign references cited therein. Also submitted therewith is a copy of the Postcard Receipt indicating the Offices' receipt of the foreign references cited therein.

Finality of Action:

Minimally, in light of the conflicting statements with respect to the Offices' possession of the foreign references cited in the IDS submitted December 7, 2004, the finality of the Office Action of July 19, 2005 should be withdrawn for entry and consideration of the references previously presented.

Further, in the Office Action of March 22, 2005, the first action in the above captioned matter, the Examiner rejected each of the claims of the present application under 35 U.S.C. §102(b) as anticipated by French reference Prunier (FR 2,536,320). MPEP §706.02.II requires that "[i]f the document is in a language other than English and the

Stein et al.

S/N: 10/605,546

examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.” (Emphasis added). The Office Action did not include a translation of the document relied on. Accordingly, not knowing what the reference states about the Figures, Applicant was unable to fully respond to the Examiner’s assertions. Without a translation of the document, rejections relying on anything more than the translated abstract thereof are clearly improper. Applicant must be given an opportunity to respond. The converse is equally true – if Applicant submits a foreign language reference for consideration, the Applicant has the burden of supplying a translation for full consideration. If the Examiner uses a foreign language document, the Examiner must supply a translation as well.

As stated in MPEP §706.07, “Before a final action is in order, a clear issue should be developed between the examiner and applicant.” MPEP §2271 further states that “[t]o bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final.” MPEP §706.07 further states that “present practice does not sanction hasty and ill-considered final rejections” and “[t]he applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.” MPEP §706.02.II requires a translation of a foreign language document that is relied upon by the examiner in a non-final action to allow an applicant an opportunity to respond.

In the Final Office Action of July 19, 2005, responding to Applicant’s arguments directed to the improper reliance on Prunier (FR 2,536,320), the Examiner states that “the 35 USC 102(b) rejections based on Prunier (FR 2,536,320) [presented in the Office Action of March 3, 2005] [were] not a result of reliance solely on the abstract” and that “the ‘French text of specification and claims; and Figure’ are also cited at the end of the paragraph.” The Examiner openly admits that the rejections were based, at least in part, on the underlying, **non-translated**, portions of the reference. The Examiner further states that “a complete translation of a foreign document can take up to several weeks to obtain” and yet further requests “that applicants employ their resources to obtain a complete translation of pertinent foreign documents upon receipt of first and/or subsequent Office Actions to enable a

Stein et al.

S/N: 10/605,546

complete reply and hasten prosecution history." Applicant is under no such duty. If the Examiner wishes to rely on a foreign reference, it is the Examiner's burden to provide proof that the document discloses what the Examiner asserts the document discloses.

The Examiner left a telephone message with the office of the undersigned on August 3, 2005 therein stating that "I do know a few French terms when I look at the specification, and I made [the rejection] final with the translation" and that in setting forth the rejections over Prunier (FR 2,536,320) "I didn't rely entirely on the Abstract." In the telephone message the Examiner further stated that "MPEP 700-21, the last two sentences; it doesn't say I can't make a final rejection" and that "it's kind of ambiguous ... but since I'm not relying entirely on the Abstract, I believe the final rejection is appropriate ... and it looks like a Petition would be the best route for you in this case." Additionally, even though MPEP §706.02.II requires that a translation must be provided, and even though an applicant has never had an opportunity to fully analyze the reference, the Examiner considers finality to be proper with initial presentation of the translated document.

The finality of the currently pending Office Action is clearly premature. Accordingly, Applicant has filed, concurrently herewith and under separate cover, a Petition to the Director under 37 C.F.R. §1.181 for review of the finality of the Office Action of July 19, 2005 and requested therein that the finality of the Office Action be withdrawn as improper.

Provisional Obviousness-type Double Patenting Rejection:

The Examiner provisionally rejected claims 1-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-43 of copending Pat. App. Ser. No. 10/604,459. As stated in MPEP §822.01, "[i]f the 'provisional' double patenting rejection is in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent." Upon consideration of the amendments/remarks presented herein, the Examiner is required to withdraw the rejection in this matter and allow the above-captioned Application to pass to issuance. That is, not until one of the above identified Applications issues as a patent will Applicant consider and/or address the appropriateness of filing a terminal disclaimer in the other co-pending matter.

Stein et al.

S/N: 10/605,546

Rejection under 35 U.S.C. §112, first paragraph:

The Examiner next rejected claims 12-17 under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner suggested that Applicant revise the format of claim 12 to improve the readability thereof. Applicant has revised claim 12 to improve the readability thereof as suggested by the Examiner. The revisions to claim 12 are merely stylistic and do not relate to the patentability of the subject matter of claim 12. Accordingly, Applicant believes that the rejection thereto has been overcome.

Rejection of Claims Over Art of Record:

The Examiner rejected claims 1-23 as anticipated by Prunier (FR 2,536,320). As stated in MPEP §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." In setting forth the rejection the Examiner has merely reproduced the elements of the independent claims and asserts that Prunier (FR 2,536,320) discloses such. The Examiner states that Prunier (FR 2,536,320) discloses "a means to maintain coolant circulation until expiration of a specific time period and until a temperature falls below a certain value (i.e., threshold, predetermined value, and/or certain set point after deactivation of the welding machine)" (Emphasis in original). The Examiner cites to "(abstract, translation of French text of specification and claims; and Figure)" as supporting the assertion. Contrary to the Examiner's assertion, there is nothing within the cited portions of Prunier (FR 2,536,320) that supports such a conclusion.

Claim 1 calls for, in part, a cooling system configured to automatically circulate coolant through a welding-type component upon activation of the welding-type component and maintain coolant circulation upon deactivation of the welding-type component if a measured coolant temperature exceeds a threshold. There is no disclosure in Prunier (FR 2,536,320) for such a system. That is, Prunier (FR 2,536,320) does not show, disclose, teach, or suggest, a welding-type system having a cooling system configured to circulate coolant through a welding-type component upon activation of the welding-type component and maintain circulation upon deactivation of the welding-type component and called for in claim 1. Further there is no suggestion in the art of the record for a cooling system as called for in claim 1 wherein the flow of coolant is maintained upon deactivation of the welding-type component if a measured coolant temperature exceeds a threshold as called for in claim 1.

Stein et al.

S/N: 10/605,546

Claim 12 calls for, in part, a controller configured to (A) regulate the cooling system such that upon activation of the welding torch coolant is automatically caused to at least flow through the welding torch; (B) monitor a temperature of the coolant after deactivation of the welding torch; and (C) continue to circulate coolant until a temperature of the coolant falls below a predetermined value. Not only does Prunier (FR 2,536,320) fail to disclose any controller, Prunier (FR 2,536,320) does not show, disclose, teach, or suggest a controller configured to automatically cause a flow of coolant through a welding torch, monitor a temperature of the coolant at any time, or as argued above with respect to claim 1, continue to circulate a coolant based on a temperature of the coolant as called for in claim 12.

Claim 18 calls for, in part, a method for cooling a welding-type component which includes maintaining coolant circulation through the welding-type component if the coolant temperature exceeds a threshold. There is no disclosure in Prunier (FR 2,536,320) for a method of cooling a welding-type component as defined in claim 18. There is no disclosure in Prunier (FR 2,536,320) that the system thereof maintains coolant circulation through the welding-type component if the coolant temperature exceeds a threshold as called for in claim 18.

Similarly, claim 23 calls for, in part, a welding-type apparatus which includes means for automatically circulating coolant through at least the means for providing welding-type power upon activation of the means for outputting welding-type power; means for determining coolant temperature; and means for maintaining coolant circulation until coolant temperature falls below a certain set point. There is no disclosure in Prunier (FR 2,536,320) for such an apparatus. Prunier (FR 2,536,320) merely discloses an apparatus having a cooling system. There is no disclosure or suggestion in Prunier (FR 2,536,320) that the system thereof automatically circulates coolant upon activation of the means for outputting welding-type power, includes means for determining coolant temperature, or means for maintaining coolant circulation until coolant falls below a certain set point as called for in claim 23.

The Examiner states that "in contrast to applicants' remarks [in the previous response], the French document includes 'dynamically controlling coolant flow'." To support this assertion the Examiner cites to the translation of Prunier (FR 2,536,320) and "the newly underlined portion of paragraph 7" of the July 19, 2005 Office Action, as cited above. Although Applicant appreciates the citation to the entirety of the fourteen pages and one

Stein et al.

S/N: 10/605,546

Figure of the translation of Prunier (FR 2,536,320), nowhere therein is it disclosed that the system 'dynamically control[s] coolant flow' or that the flow of coolant flow is determined by a temperature value. There is no disclosure in the translation of Prunier (FR 2,536,320) for how the flow of coolant is controlled. To conclude that the reference discloses the claimed system is simply not supported by the reference. The Examiner's lack of any citation other than to the entirety of the document along with the quotation of information that is not in the translation indicates the references failure to disclose a system as claimed. The Examiner has merely reproduced the majority of the independent claims and asserted that such is disclosed in Prunier (FR 2,536,320) via citation to the entirety of the translation thereof. For purposes of appeal, should the Examiner wish to maintain the rejection of the present claims as anticipated by Prunier (FR 2,536,320), Applicant respectfully requests that the Examiner provide citations to the body of the reference to support the rejections. As argued above, a system as called for in the claims of the above-captioned Application is not shown, disclosed, taught, or suggested in the Prunier (FR 2,536,320).

In addition to the rejection of claims 1-23 as anticipated by Prunier (FR 2,536,320), the Examiner redundantly rejected claims 1-23 under 35 U.S.C. §102(b) based on Behnke et al. The reference indicated that it is desirable "to provide an automatic control for cutting off the flow of cooling water after the electrode has cooled below [an] oxidation temperature." Col. 1, lns. 24-27. Applicant agrees that such an object is desirable. However, contrary to the conclusion of the Examiner, the reference teaches a method and system to cool that is substantially different from that claimed.

Specifically, the reference teaches a timed control loop whereupon a length of time is predetermined and coolant allowed to flow until expiration of that length of time on the presumption that the torch will cool to a desired temperature during that length of time. That is, Behnke et al. states that "[w]hen the welding arc is extinguished by removing the electrode from proximity to the workpiece, the relay 10 is energized to close its switch 18, energize the timer 14 and start its motor 28 running." Col. 3, lns. 55-59. In this regard, "At the expiration of the time delay period, the timer 14 opens its switch 27 which closes the argon valve 15 and the water valve 16." Col. 3, lns. 59-61. Accordingly, coolant flows until a timer expires. With this technique, coolant flow ceases regardless of the actual temperature of the welding torch or coolant. If the torch or coolant temperature is at or below the given temperature before expiration of the timer, coolant still flows. This continued flow

Stein et al.

S/N: 10/605,546

unnecessarily expends energy and thus contributes to system inefficiency. Similarly, coolant flow ceases at the expiration of the timer even if actual torch or coolant temperature exceeds the desired temperature. That is, with the system of Behnke et al., there is a presumption that the set time of the timer is of sufficient length to provide for adequate cooling. However, it is well-understood that for different welding applications, different cooling times may be required and with the system of the reference, a "presumed" temperature may not match actual temperature.

In contrast, claims 1-23 call for a method and/or system whereby coolant flow is maintained after deactivation of a welding-type process until the temperature of the coolant and/or welding-type component exceeds a threshold. That is, claim 1 calls for, in part, a cooling system that is configured to automatically circulate coolant through at least the welding-type component upon activation of the welding-type component and maintain coolant circulation upon deactivation of the welding-type component if a measured coolant temperature exceeds a threshold. Claim 12 calls for, in part, a controller configured to regulate a cooling system such that upon activation of a welding torch coolant is automatically caused to at least flow through the welding torch and monitor a temperature of the coolant after deactivation of the welding torch, and continue to circulate coolant until a temperature of the coolant falls below a predetermined value. Claim 18 calls for, in part, the step of maintaining coolant circulation through the welding-type component if the coolant temperature exceeds a threshold. And, claim 23 calls for, in part, means for maintaining coolant circulation until coolant temperature falls below a certain set point. The Examiner maintains that Behnke et al. "discloses and/or implies a 'threshold', 'predetermined value', and/or 'certain set point' have been obtained to enable 'cutting off the flow of water'." The Examiner continues, "In other words, if the electrode in the Behnke et al. invention is above 'oxidation temperature', then coolant would continue to flow until it is below the 'oxidation temperature'" and that "[a]s a result, all of independent claims 1, 12, 18, and 23 (and claims dependent therefrom) do not patentably distinguish over Behnke et al." The Examiner has disregarded the express disclosure of Behnke et al. and the elements set forth in the present claims in a strained effort to produce a redundant 35 U.S.C. §102(b) rejection of the present claims. There is simply no disclosure in Behnke et al. that the coolant system thereof circulates coolant for a duration determined by the temperature of the coolant as called for in the present claims. Behnke et al. expressly discloses that the coolant is circulated for a

Stein et al.

S/N: 10/605,546

predetermined time, i.e. regardless of the temperature of the coolant. That which is called for in the present claims is simply not shown, disclosed, taught, or suggested in the art of record, or any combination thereof. As such, claims 1-23 are believed to be patentably distinct thereover.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-23.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



Kirk L. Deheck
Registration No. 55,782
Direct Dial 262-376-5170
kld@zpspatents.com

Dated: September 22, 2005
Attorney Docket No.: ITW7510.074

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170